

09/558,031

MS147303.01/MSFTP110US

REMARKS

Claims 1-46 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claims 1-46 Under 35 U.S.C. §103(a)

Claims 1-46 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Berstis (U.S. 6,785,869). Reconsideration and allowance of these claims is respectfully requested for at least the following reasons. Berstis fails to disclose each and every aspect as recited in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success *must both be found in the prior art and not based on applicant's disclosure*. See *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The subject invention relates generally to communication of definitional data to a client requesting such data, wherein a communications channel is opened in response to selection of an element. To that end, independent claim 1 recites *a client device programmed to create a communications channel in response to selecting an element displayed on a page and to communicate information about the element via the communications channel, the client device displaying on the page definitional information related to the selected element based on response data received via the communications channel; wherein the creation of the communications channel is event driven and*

09/558,031

MS147303.01/MSFTP110US

responsive to at least one user-generated event. Berstis does not disclose or suggest these claimed aspects (or features recited in claims 14, 27, and 37).

The cited reference discloses a spell check application that can be updated by a user, and the updates can be delivered to several clients. As described in previous correspondence and reiterated herein, however, it is readily apparent that Berstis fails to disclose, teach, or suggest *a client device programmed to create a communications channel in response to selecting an element* as recited in independent claim 1. Rather, Berstis teaches updating a spell check glossary in a client upon a server determining that an application that employs the spell check glossary is being utilized. Thus it can be discerned that a communications channel between the client and the server is pre-existent, and that the client is not *programmed to create a communications channel in response to selecting an element* as claimed.

In an attempt to overcome this deficiency, the Examiner essentially asserts in the Advisory Action dated August 11, 2005 that it would be obvious to one of ordinary skill in the art to undertake changes (that are neither taught nor suggested) to what is described in Berstis to render the claimed invention obvious. Applicants' representative submits, however, that this reasoning is an improper basis upon which to maintain this rejection. Rather, in order to maintain this rejection, the Examiner must provide some teaching or suggestion of *a client device programmed to create a communications channel in response to selecting an element*.

To establish a case of obviousness, the cited reference(s) must provide "a teaching, suggestion, or reason to substitute [an element or limitation] ... in the prior art. *The absence of such a suggestion to combine is dispositive in an obviousness determination.*" *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 U.S.P.Q.2d 1378 (Fed. Cir. 1997).

Thus, absent a teaching or suggestion of *creating a communications channel in response to selecting an element*, Berstis alone is insufficient to maintain this rejection under 35 U.S.C. §103(a).

In an attempt to provide the requisite teaching or suggestion, the Examiner cites a

09/558,031

MS147303.01/MSFTP110US

portion of Berstis that describes a client as a network computer, wherein the client is not associated with a hard drive or a disk drive. (See col. 4, lines 52-59). The Examiner then asserts that "it would have been obvious to one of ordinary skill in the art to extrapolate the alternative embodiments described to see how a network computer would need to communicate with a server when dictionary information was needed." It is clear, however, that a communication channel must be pre-existent between a network computer and a server, as the network computer has no local storage for running an application (as conceded by the Examiner). In other words, a communication channel between the network computer and the server must be created prior to opening an application and must be maintained to enable continued use of such application. Thus, even if a client computer is a network computer as described in Berstis, there remains a lack of teaching or suggestion of *creating a communications channel in response to selecting an element* as claimed.

As Berstis fails to teach or suggest each and every element of applicants' claimed invention, it is readily apparent that the rejection with respect to claims 1, 14, 27, and 27 (and all claims that depend therefrom) should be withdrawn.

09/558,031

MS147303.01/MSFTP110US

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063[MSFTP110US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin

Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731